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REMARKS

This Amendment is submitted simultaneously with filing of the Request for Continuing Examination and in response to the decision on appeal.

The Decision on Appeal has been carefully considered.

In connection with this, the original claims have been canceled, and a new set of claims including claim 19, the broadest claim on file, and claim 20 which depends on claim 19 has been submitted.

It is respectfully submitted that claim 19 clearly and patentably distinguishes over the prior art applied in the decision on appeal.

The patent to Tsoi discloses a mobile telephone user interface including fixed and dynamic function keys and method of using the same. This reference does not provide any hint or suggestion that, on the one hand, the control element has no function and the displayed icon which is assigned to the control element only serves as information, and, on the other hand, the

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control element has a function with respect to the displayed icon. The embodiment illustrated in Figures 5a and 5b shows this solution.

The advantage of this solution, which can not be achieved by the system disclosed in the patent to Tsoi, is that the information corresponds in one operating state to a function, which is in the other state not active but visible to the user, as explained in particular page 6, line 28 to page 7, line 2, and on page 7 lines 14-19 of the specification of the present application.

In the Decision on Appeal it was stated that the claimed subject matter was met by Tsoi alone and the claims were rejected under 35 U.S.C. 103.

It is respectfully submitted that claim 19 now defines the features which are not disclosed in the patent to Tsoi and can not be considered as obvious from it. The reference does not contain any hint or suggestion for such features. In order to arrive at the applicant's invention as now defined in claim 19, the system proposed in the patent to Tsoi has to be fundamentally modified and in particular by including into it the new features which are now defined in claim 19 and was first proposed by the

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applicant.

However, It is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification. This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the reference does not provide any hint or suggestion for such modifications.

As explained herein above, the present invention provides for the highly advantageous results, which can not be accomplished by the system disclosed in the reference. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case Ex parte Tanaka, Marushima and Takahashi (174 USPQ 38), as follows:

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Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claim 19 should be considered as clearly and patentably distinguishing over the prior art applied against the original claims and should be allowed.

Claim 20 depends on claim 19, it shares its presumably allowable features, and therefore it should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be

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carried out by Examiner's Amendment, and the case be passed to issue.
Alternatively, should the Examiner feel that a personal discussion might
be helpful in advancing this case to allowance, he is invited to telephone
the undersigned (at 631-549-4700).

Respectfully submitted,



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